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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,525	10/06/2003	Michael Sujue Wang		3969

7590
Mr. Walter J. Tencza Jr.
Suite 3
10 Station Place
Metuchen, NJ 08840

12/28/2006

EXAMINER

LI, SHI K

ART UNIT	PAPER NUMBER
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2613

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/679,525	Applicant(s) WANG, MICHAEL SUJUE	
	Examiner Shi K. Li	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003 and 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 6,11-17 and 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-10,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species 11 in the reply filed on 17 October 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). In the response, Applicant states that claims 1-5, 7-10, 18-19 and 21-22 are readable on species 11. As admitted by Applicant, claim 20 does not read on species 11. Since claims 21-22 depends on claim 20, they do not read on species 11. The Examiner has explained the above to Walter J. Tencza Jr. during a phone interview on 22 December 2006. We have agreed that claims 21-22 do not read on species 11. Therefore, claims 6, 11-17, 20-28 are withdrawn as being directed to non-elected invention. The election requirement is made final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Yueh (U.S. Patent 7,030,864 B2).

Regarding claims 1 and 18, Yueh discloses in FIG. 4 a pen shaped device comprising an optical transmitter 49 and an optical receiver 50.

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Regarding claim 4, Yueh teaches in col. 3, line 19 CPU for determining amount of movement of the pen.

Regarding claim 19, Yueh teaches in FIG. 4 a tip area 12 where optical signal is reflected.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yueh (U.S. Patent 7,030,864 B2) in view of Resnick et al. ("Physics" by R. Resnick et al., John Wiley & Sons, 1966, pp. 57-61) and Yang et al. (U.S. Patent 7,098,894 B2).

Yueh has been discussed above in regard to claims 1, 4 and 18-19. Regarding claims 2-3, the difference between Yueh and the claimed invention is that Yueh does not teach determining location. Resnick et al. teaches on page 59, equation (4-5b) that location can be calculated if the movement is known. Yang et al. teaches in col. 12 lines 35-40 that the movement and position of a mouse pen usually corresponds to the movement and position of a cursor to be displayed on a monitor. One of ordinary skill in the art would have been motivated to combine the teaching of Resnick et al. and Yang et al. with the pen shaped device of Yueh to calculate the position of the pen shaped device because it is necessary to indicate the movement and position of a cursor on a monitor corresponding to the movement and position of a mouse pen. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine both

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location and movement of the pen shaped device, as taught by Resnick et al. and Yang et al., in the pen shaped device of Yueh because it is necessary to indicate the movement and position of a cursor on a monitor corresponding to the movement and position of a mouse pen.

Regarding claims 5 and 7, Yueh teaches in FIG. 6 a pen shaped device with a tip that is asymmetrically located at one end of the pen shaped device.

Regarding claims 8-9, Yueh teaches in FIG. 4 wireless transmitter 29.

6. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Yueh, Resnick et al. and Yang et al. as applied to claims 2-3, 5 and 7-9 above, and further in view of Ziemer et al. ("Principles of Communication" by R.E. Ziemer and W.H. Tranter, Houghton Mifflin Comp, 1976, p. 4).

Yueh, Resnick et al. and Yang et al. have been discussed above in regard to claims 2-3, 5 and 7-9. The difference between Yueh, Resnick et al. and Yang et al. and the claimed invention is that Yueh, Resnick et al. and Yang et al. do not teach a modulator. Ziemer et al. teaches on page 4, lines 1-5 that it is often to include a modulator in a transmitter for modulating a carrier for transmission. One of ordinary skill in the art would have been motivated to combine the teaching of Ziemer et al. with the modified pen shaped device of Yueh, Resnick et al. and Yang et al. because a modulator changes the frequency of signal to take advantage of the frequency characteristics of the transmission medium, e.g., for reducing transmission loss or meeting regulation. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a modulator in the transmitter, as taught by Ziemer et al., in the modified pen shaped device of Yueh, Resnick et al. and Yang et al. because a modulator changes

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the frequency of signal to take advantage of the frequency characteristics of the transmission medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shi K. Li whose telephone number is 571 272-3031. The examiner can normally be reached on Monday-Friday (8:30 a.m. - 5:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

skl
24 December 2006



Shi K. Li
Patent Examiner